REMARKS

This response is intended as a full and complete response to the final Office Action mailed September 17, 2007. In the Office Action, the Examiner notes that claims 1-20 are pending and rejected. By this response, Applicant has amended claims 1, 3, 4, 6, 7, 11, 13 and 15-17 and canceled claims 2, 9, 14 and 18-20.

In view of both the amendments presented above and the following discussion, Applicant submits that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Further, Applicant submits that all of the claims comply with the written description requirement of 35 U.S.C. §112, ¶1. Thus, Applicant believes that all of the claims are now in allowable form.

It is to be understood that Applicant, by amending the claims, does not acquiesce to the Examiner's characterizations of the art of record or to Applicant's subject matter recited in the pending claims. Further, Applicant is not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant response including amendments.

35 U.S.C. §112, ¶1 Rejection of Claims 4, 10, 12 and 18

Claims 4, 10, 12 and 18 are rejected under 35 U.S.C. §112, ¶1, as failing to comply with the written description requirement, the Examiner stating that the disclosure as originally filed provides a favorites menu based upon frequently watched channels and contains no explicit support for providing joint viewing. Responsive to the Examiner, the Applicants herein amend the claims back to claiming a favorites menu and further amend the claims to clarify how the favorites menu is generated. Support for the amendments may be found in the priority application 07/991,074 on at least page 105, line 15 to page 106, line 11. Consequently, the Applicants respectfully submit that the claims now fully satisfy the requirements of 35 U.S.C. § 112, paragraph 1 and respectfully request the rejection be withdrawn.

35 U.S.C. §103 Rejection of Claims 1-20

Claims 1-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over

Strubbe (5,223,924, hereinafter "Strubbe '924) in view of McMullan, Jr. (5,251,324, hereinafter "McMullan"). The rejection is traversed.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Thus, it is impermissible to focus either on the "gist" or "core" of the invention, Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 USPQ 416, 420 (Fed. Cir. 1986) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988). The Strubbe '924 and McMullan references alone or in any permissible combination fail to teach or suggest Applicant's invention as a whole.

Applicant's amended claim 1 recites:

> 1. A set top terminal for generating an interactive electronic program guide for display on a television connected to the set top terminal, the terminal comprising:
> means for retrieving information via a program control information signal of a program selected from a plurality of programs and watched by a subscriber;
> means for storing said information;
> means for identifying frequently-watched programs most often watched by said subscriber based upon said stored information;
> means for receiving a television signal;
> means for extracting individual programs from the television signal;
> means for generating an electronic program guide for controlling display of content on a television screen, the guide comprising:
> a favorites menu including names of programs available for selection, wherein the programs included in the favorites menu are based on the identified frequently-watched programs; and
> means for receiving selection signals from a user input.

Strubbe '924 fails to teach or suggest at least "means for retrieving information via a program control information signal of a program selected from a plurality of programs and watched by a subscriber" and "means for identifying frequently-watched

programs most often watched by said subscriber based upon said stored information", as recited in claim 1.

Strubbe '924 discloses a user interface which can access downloaded TV program information and automatically correlate this information with the preferences of the user. The correlation is created by receiving input from a user as to whether the user "likes" or "dislikes" the program. (See Strubbe '924, col. 4, ll. 59-64). Alternatively, the system may automatically register a "like" response if a user records or watches a program for longer than a given amount of time. (See *Id.* col. 5, ll. 23-32).

In contrast, the Applicants invention teaches a means for retrieving information via a program control information signal of a program selected from a plurality of programs and watched by a subscriber, means for storing the information, a means for identifying frequently-watched programs most often watched by said subscriber based upon said stored information and generating a favorites menu of programs based upon said identified frequently-watched programs. In other words, the Applicants' invention may learn by determining which channels or programs are most often watched over a period of time. In contrast, Strubbe '924 learns which programs are favorites based upon a direct input from the user (i.e. whether it be a "like" input, a "dislike" input or a program record input). Consequently, the Applicants' invention provides a passive method for collecting favorite program information from a user and identifying favorite programs that is not taught by Strubbe '924.

Furthermore, McMullan fails to bridge the substantial gap between Strubbe '924 and Applicant's claimed invention of at least claim 1. McMullen also fails to teach or suggest at least "means for retrieving information via a program control information signal of a program selected from a plurality of programs and watched by a subscriber" and "means for identifying frequently-watched programs most often watched by said subscriber based upon said stored information," as positively claimed by the Applicant's invention. McMullen only teaches suggesting programs based on the individual profiles. (See McMullen, col. 25, ll. 63-68.)

Therefore, even if Strubbe '924 and McMullen were combined, the combination would fail to teach or to suggest at least "means for retrieving information via a program

control information signal of a program selected from a plurality of programs and watched by a subscriber" and "means for identifying frequently-watched programs most often watched by said subscriber based upon said stored information." As a result, the Applicants independent claims are clearly patentable over Strubbe '924 and McMullen.

Independent claims 7 and 16 recite relevant limitations similar to those recited in independent claim 1. Accordingly, for at least the same reasons discussed above, independent claims 7 and 16 also are patentable over Strubbe in view of McMullan under 35 U.S.C. §103(a).

Furthermore, Claims 3-6, 8, 10-14, 15 and 17 depend, directly or indirectly from independent claims 1, 7 and 16, while adding additional elements. Therefore, these dependent claims also are patentable over Strubbe '924 and McMullan under 35 U.S.C. §103 for at least the same reasons discussed above in regards to independent claims 1, 7 and 16. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

Secondary References

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to Applicant's disclosure than the primary references cited in the Office Action. Therefore, Applicant believes that a detailed discussion of the secondary references is not necessary for a full and complete response to this Office Action.

CONCLUSION

Thus, Applicant submits that all of the claims presently in the application are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jimmy Kim, at (732) 530-9404, so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 11/19/07

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